

Application No. 09/724,265
Amendment dated July 30, 2003
Reply to Office Action of January 30, 2003

REMARKS

Claim 1 has been amended. Claim 17 has been canceled. The claims have been rewritten to place them in better form for examination and to further obviate the 35 U.S.C. §§102, 103 and 112 rejections set forth in the Office Action dated January 30, 2003. It is believed that none of these amendments constitute new matter. Withdrawal of these rejections is requested.

Claims 1, 2, 4, 7-20, 56-61 and 63-65 are rejected under 35 U.S.C. §112, 2nd paragraph. The Examiner states that claim 1(c) "aerosol droplets" lacks antecedent basis. Applicant submits that "aerosol droplets" is first in claim 1(b) and then in 1(c), 1(d) and 1(e). The Examiner has rejected claims 1, 19 and 20 as being incomplete methods because the desired product is not produced in the final step of the method. Applicant has amended claim 1 by adding a final step of the method as suggested by the Examiner. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 17 is rejected under 35 U.S.C. §112, 1st paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has canceled claim 17. Withdrawal of this rejection is respectfully requested.

Claims 1, 2, 4, 7-10, 13-20, 56-67, 61 and 63 are rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Mets, US 5,240,842 issued August 31, 1993. Applicant submits herewith a Declaration under 37 CFR §1.132, by Herbert M. Wilson which discusses differences between Mets and the present invention. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1, 2, 4, 7-10, 13-20, 56-58, 60, 61 and 63-65 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mets as discussed above, and further in view of Pui et al., WO 98/56894, publication date 17 December 1998. Applicant submits herewith

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a Declaration under 37 CFR §1.132 by Herbert M. Wilson which discusses differences between Mets and Pui and the present invention.

It is settled law that "elements of separate patents (or publications) cannot be combined when there is no suggestion of such combination anywhere in those patents (or publications) . . .; and a court (or PTO) should avoid hindsight . . ." *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ 2d 1593, 1597 (Fed. Cir. 1987), citing *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed Cir. 1984). See also *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 5 USPQ 2d 1434, 1438-1441 (Fed. Cir. 1988).

In addition, it is well established law that both the suggestions and a reasonable expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Dow Chemical*, 5 USP 1529, 1531 (Fed. Cir. 1988). *In re O'Farrell*, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988). Applicant submits that the cited references, when viewed separately or in combination do not teach or suggest the claimed invention and that the Examiner has used an impermissible "obvious to try" standard in reaching the conclusion that Applicant's invention is obvious. *In re O'Farrell, supra*.

None of the references cited by the Examiner discloses or suggests using low flow rates with the aerosol beam method of the present invention. Therefore, there is no *prima facie* case of obviousness.

The determination of obviousness cannot be made without consideration of Applicant's invention as a whole. As the Federal Circuit has stated,

... at all costs, the mistake of picking random bits of various prior art references and employing them as a "mosaic to recreate a facsimile of the claimed invention" must be avoided.

W. L. Gore and Assoc. v. Garlock, Inc., 220 USPQ 303, 311 (Fed. Cir. 1983), citations omitted.

Applicant submits that the Examiner has randomly picked bits of prior art references using the hindsight provided by Applicant's disclosure.

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A determination of obviousness cannot be made without consideration of the particular problems faced by the inventor. As stated by the Court of Customs and Patent Appeals,

[v]iewed after the event, appellant's invention may appear to be simple and as such obvious to those of ordinary skills in this art. This, however, is not a basis upon which to reject the claims. Where the invention of which a patent is sought solves a problem which persisted in the art, we must look to the problem as well as to its solution if we are to properly appraise what was done and to evaluate it against what would be obvious to one having ordinary skills in the art.

In re Rothermel and Waddel, 125 USPQ 328, 332 (CCPA 1960).

In addition, the Federal Circuit has held that a determination of obviousness requires that there be a suggestion in the prior art that would lead a person of ordinary skill to the same solution of the problems facing the applicant. *Stratoflex v. Aeroquip*, 218 USPQ 871 (Fed. Cir. 1983).

Part of Applicants' invention was understanding the problems involved, including using low flow rates.

In view of these facts, it is submitted that the Examiner's imputed conclusion of obviousness could only have been reached with the benefit of the hindsight application of the teachings of the present specification. As a result, it is respectfully submitted that the rejection be withdrawn.

In view of the above amendments and remarks, it is submitted that the claims satisfy the provisions of 35 U.S.C. §§ 102, 103 and 112 and are not obvious over the prior art. Reconsideration of this application and early notice of allowance is requested.

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT REQUIRED			
NAME AND REG. NUMBER	Robert J. Jondle, Reg. No. 33,915		
SIGNATURE		DATE	July 30, 2003

Attachments: Declaration of Herbert M. Wilson under 37 CFR §1.132